

DEEP & FAR *Attorneys-at-Law* 13th Fl., 27 Sec. 3, Chung San N. Rd., Taipei 104, Taiwan, R.O.C.

May 11, 2011

Thomas B. Haverstock, Esq.
Haverstock & Owens LLP
162 North Wolfe Road
Sunnyvale, California 94086
U. S. A.

FAX TRANSMISSION
AIRMAIL CONFIRMATION

Total 9 Pages

Re: Taiwanese Patent Application No. 93102688 Entitled "Main Menu Navigation Principle for Mobile Phone User" based on US Patent Serial No. 60/445,939 filed February 6, 2003 In the name of Flextronics Sales & Marketing (A-P) Ltd.
Inventor(s): Thor Itt CHIAM; Bassam JABBY
Assignee: Flextronics AP, LLC
Your Ref.: FLEX-00300TW
Our Ref.: PICIA12435/1599-SH

RECEIVED WITH THANKS
HAVERSTOCK & OWENS LLP

Dear Haverstock, Esq.:

Enclosed please find a copy of the Notification of Rejection Decision issued on April 26 and received on April 27, 2011 together with its English translation regarding the above-captioned application. A response to the Notification of Rejection Decision should be submitted on or before the deadline, June 26, 2011.

The opinions raised by the Examiner could be seen in the attached English Translation of the Notification. Please kindly acknowledge safe receipt of this letter by return fax or by E-Mail.

After reviewing the Examiner's opinions in the Rejection Decision, the following suggestions are provided herein.

Regarding Item 2), the Examiner still alleges that the distinguishing technical features "the two-dimensional navigation key is configured to allow viewing sub-menu items of a sub-menu associated with another main menu item directly from the sub-menu associated with the selected main menu item by a single access of the two-dimensional navigation key" in each of the present independent claims are supported by neither the specification nor the figures of the present application. Please kindly further advise how the skilled person could derive the above features from the technical scheme of scrolling between two control levels as disclosed in Page 7, Lines 24-27 of the present specification.

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Regarding Item 3).1, the Examiner still alleges that there should be no difficulty for the skilled person to combine the technical features of the cited references 1 and 3 since the following features have been disclosed in the cited reference 3: "selecting a main menu and displaying the sub-menu thereof by pressing the navigation key, wherein the different pressing direction will define the different main menu, and the sub-menu items of the address book will be displayed when pressing the address book under the sub-menu of the message". Please kindly advise how the skilled person could realize the above quoted technical features have not been disclosed in Paragraphs [0042] and [0045] of the cited reference 3.

Regarding Item 3).2, please be advised that the alleged issues regarding the dependent claims will be addressed if the respective patentability of the independent Claims 1, 18 and 23 is established.

Regarding Item 4, please be advised we will straightforwardly deal with the issue resulting from the syntax preferred by the Examiner.

In order to have a timely response, please let us have your instructions and/or comments and/or opinions on this Notification preferably by June 11, 2011 in order that we can act accordingly. Please be advised that if we could not receive your comments and/or instructions by June 19, 2010, we will file a petition for a two-month extension.

Please feel free to contact us if you have any questions or comments.

Very truly yours,

DEEP & FAR



CFT/Sean Hsuei

for C. F. Tsai

Encls.

1. a copy of the Notification of Rejection Decision together with its English translation

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English Translation of the Notification of Rejection Decision

(Issued to Taiwanese Patent Application No. 093102688)

1. Application Number: 093102688
2. Title of the Invention: Main Menu Navigation Principle for Mobile Phone User
3. Applicant:
Name: Flextronics Corporation
Location: US
4. Attorney:
Name: C.F. Tsai, Patent Attorney
Address: F. 13, No. 27, Sec. 3, Chung San N. Road, Taipei
5. Filing Date: February 5, 2004
6. Priority Date: February 6, 2003 US Patent Application No. 60/445,939
7. Examiner: R. H. Hsu
8. Decision Contents:

Subject: the present application shall not be granted.

Based on: Article 44 of the Patent Law

Descriptions:

1) The Examiner issued the Notification of Examination Opinions of No. (98) IP 2(3) 04123 No. 09920840100 for the present application entitled "Main Menu Navigation Principle for Mobile Phone User" on November 22, 2010, which describes the reasons for not granting the present application in detail. The Applicant submitted a Response to the Notification with amended texts on February 23, 2011. The Examiner resumes examination based on the amended specification, which includes 26 claims, wherein Claims 1, 18 and 23 are independent claims, and others are dependent ones.

2) It is described in the second and third paragraphs of Page 2 of the Response to the Notification that the recitations, "wherein the two-dimensional navigation key is configured to allow viewing sub-menu items of a sub-menu associated with another main menu item directly from the sub-menu associated with the selected main menu item by a single access of the two-dimensional navigation key", can be supported by the descriptions of the present invention. However, these paragraphs mentioned in the response merely describe the embodiment of selecting a main menu and a plurality of sub-menus thereof. Besides, the descriptions of allowing scrolling among at least two control levels by a single access of the two-dimensional navigation key 115 has not sufficiently disclosed whether the two control levels are a main menu and a sub-menu, or a main menu and another main menu. Therefore, the recitations, "wherein the two-dimensional navigation key is configured to allow viewing sub-menu items of a sub-menu associated with another main menu item

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directly from the sub-menu associated with the selected main menu item by a single access of the two-dimensional navigation key", still cannot be supported by the descriptions of the present invention.

3) According to the disclosures of the cited references 1 and 3 of the Notification of Examination Opinions, the present Claims 1 and 3 to 25 fail to comply with the requirements of Paragraph 4 of Article 22 of the Patent Law. According to the disclosures of the cited references 1 to 3 of the Notification of Examination Opinions, the present Claims 2 and 26 fail to comply with the requirements of Paragraph 4 of Article 22 of the Patent Law.

3).1 With regard to Claims 1, 18 and 23, it is asserted in the Response that the examining opinions based on the combination of the cited references 1 and 3 are improper. However, those technical features as described in the cited references 1 and 3 shall not be considered as not being combinable in nature, since they both relate to technologies of cellular phones and the design for selecting menu items. It is also asserted that the cited references 1-3 have not disclosed the technical features "wherein the two-dimensional navigation key is configured to allow viewing sub-menu items of a sub-menu associated with another main menu item directly from the sub-menu associated with the selected main menu item by a single access of the two-dimensional navigation key". However, the technical features "selecting a main menu and displaying the sub-menu thereof by pressing the navigation key, wherein the different pressing direction will define the different main menu, and the sub-menu items of the address book will be displayed when pressing the Address Book under the sub-menu of the message" in Figs. 1 and 3A to 3C and the relevant descriptions of the cited reference 3 teach the features "wherein the two-dimensional navigation key is configured to allow viewing sub-menu items of a sub-menu associated with another main menu item directly from the sub-menu associated with the selected main menu item by a single access of the two-dimensional navigation key". Therefore, the abovementioned arguments are not persuasive.

3).2 The reasons for Claims 1 to 26 lacking patentability are the same as those described in the last Notification of Examination Opinions.

4) The Applicant has amended the phrase "single 觸及" to "single 存取" in the invention descriptions and claims. The feature "存取" cannot be directly as well as undoubtedly derived from the feature "觸及", and there is not a superordinate or subordinate relation thereinbetween. Therefore, such amendments go beyond the disclosure of the original specification and figures, which fails to comply with the requirements of Paragraph 4 of Article 49 of the Patent Law.

Based on the above, the present application does not meet the requirements of Paragraph

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4 of Article 22 and Paragraph 3 of Article 26 of the Patent Law. According to Article 44 of the Patent Law, the decision is made as described in the above subject.

If dissatisfied with this Office Action, the Applicant can request a re-examination by submitting the re-examination briefs in duplicate to the IPO and paying the Official Fees of NT\$8000 within 60 days following the day of receipt of this Office Action. (Every extra 50 pages will have to pay extra NT\$500 if the specification (including the drawings) has more than 50 pages. The extra pages will be regarded as 50 pages if they are less than 50 pages.)

正本

檔 號
保存年限

經濟部智慧財產局專利核駁審定書

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104 雙掛號
臺北市中山區中山北路3段27號13樓受文者：偉創力公司（代理人：蔡清
福 專利師）發文日期：中華民國100年4月26日
(100)智專二(三)04123字第

發文文號：10020338630 號

速 別： *1002033863001*

密等及解密條件或保密期限：

附 件：

IPC: H04M 1/247 (2006.01)

- 一、申請案號數：093102688
- 二、發明名稱：行動電話使用者主選單操控裝置
- 三、申請人：
- 名稱：偉創力公司
- 地址：美國
- 四、代理人：
- 姓名：蔡清福 專利師
- 地址：臺北市中山區中山北路3段27號13樓
- 五、申請日期：93年2月5日
- 六、優先權項目：
- 1 2003/02/06 美國 60/445,939
- 七、審查人員姓名：許瑞雄 委員
- 八、審定內容：



主文：本案應不予專利。

依據：專利法第44條。

理由：

(一)本案「行動電話使用者主選單操控裝置」曾於99年11月22日以<99>智專二(三)04123字第09920840100號審查意見通知函，詳述本案應不予專利之理由，並於100年2月23日提出申復、修正到局，本案依該修正說明書內容審查，申請專利範圍共26項，其中第1、18、23項為獨立項，其餘為附屬項。

(二)申復理由第2頁第2及3段敘明「其中該二維操控件配置成可直接從相關於該選定主選單項目的該次選單中，藉由該二維操控鍵的單一存取，觀看相關於另一主選單項目的一次選單的次選單項目」可為發明說明支持，惟查申復理由所述之段落僅說明選定主選單與該選定主選單之複數次選單之實施方式；另發明說明中所載之藉由二維操控鍵115的單一次存取，達成在至少兩控制階層之間捲動，並未充分揭露兩控制階層為主選單與次選單或主選單與另一主選單，故「其中該二維操控件配置成可直接從相關於該選定主選單項目的該次選單中，藉由該二維操控鍵的單一存取，觀看相關於另一主選單項目的一次選單的次選單項目」仍不為發明說明所支持。

(三)依據前開審查意見通知函所載引證1及3所揭示內容，本案申請專利範圍第1、3至25項；依據引證1至3所揭示內容，本案申請專利範圍第2、26項，違反專利法第22條第4項之規定。

1、請求項1、18、23，申復理由主張引證1及3之結合不恰

當，惟查引證1及3均為手機及關於設計選單項目之技術，應不屬於先天不相容之技術特徵；另主張引證1至3未揭示「其中該二維操控件配置成可直接從相關於該選定主選單項目的該次選單中，藉由該二維操控鍵的單一存取，觀看相關於另一主選單項目的一次選單的次選單項目」等技術特徵，惟查引證3圖式第1、3A至3C圖及相關說明所揭示之「藉由按壓操控鍵選擇主選單及顯示該主選單之次選單，其中以按壓方向之不同定義不同主選單，當在訊息之次選單下按壓Address Book即可顯示Address Book之次選單項目」，具有教示「其中該二維操控件配置成可直接從相關於該選定主選單項目的該次選單中，藉由該二維操控鍵的單一存取，觀看相關於另一主選單項目的一次選單的次選單項目」，故申復理由不成立。

2、請求項1至26不具專利要件之理由同原審查意見通知函所述。

(四)發明說明及請求項多處將「單一觸及」修正為「單一存取」，其中觸及無法直接且無歧異推知存取，且無上下位之關係，故此修正已超出申請時原說明書或圖式所揭露之範圍，違反專利法第49條第4項之規定，併予指明。

據上論結，本案因違反專利法第22條第4項、第26條第3項之規定，爰依專利法第44條，審定如主文。

局長 **王 美 花**

依照分層負責規定
授權單位主管執行



如不服本審定，得於文到之次日起60日內，備具再審查理由書一式2份及規費新台幣8千元整（專利說明書及圖式合計在50頁以上者，每50頁加收新台幣5百元，其不足50頁者以50頁計），向本局申請再審查。

※本局依據政府資訊公開法，將開放民眾線上調閱依法公開之專利案件審查資訊，申請人注意於提出各項專利申請（如補充修正、申復、更正、再審查、分割、改請等）時，請使用本局公告之專利申請表格，並勿於申請書以外之附件（如說明書、圖式及各式理由書）中填寫不同意公開之個人資料或簽章，以免附件之影像檔公開時損及個人權益。

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